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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,892	02/17/2004	Kishore Tipirneni	40500.0117	9636
20322	7590	11/16/2005	EXAMINER	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001			AMARELD JR, ROBERT W	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/779,892	Applicant(s) TIPIRNENI, KISHORE	
	Examiner Robert W. Amareld, Jr.	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☒ Claim(s) 11 and 22-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: In the remarks of the preliminary amendment dated 2/17/04 the applicant clearly states to amend paragraph [0031], however the applicant later states to replace paragraph [0032] with the re-written paragraph. The amendment appears to be a re-written paragraph [0031] and will be treated as such.

Claim Objections

Applicant is advised that should claim 1 be found allowable, claim 11 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The only difference between these claims lies within the functional language of the preamble, this is an insufficient difference to allow for differing patentable subject matter.

Claims 22-24 are objected to because of the following informalities: Claims 22-24 incorrectly dependently reference claim 11 as a method claim. Since claim 17 represents the sole independent method claim, it is apparent that the applicant meant to

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reference claim 17, not claim 11 in the new claims 22-24. Claims 22-24 will be treated as being dependant on claim 17.

Claim Rejections - 35 USC § 112

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "said wire and gears" in line 2 of claim 9. There is insufficient antecedent basis for this limitation in the claim. Gears are not previously mentioned within any of the claims. Additionally, the gears are mentioned in a functional capacity and do not appear to be part of the structural claims of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5,11, 12, 14,15 17, 19 & 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Lichty (US Pat# 4456005). Lichty discloses a system including a head (16) configured to attach to the wire (22) which has a first and second ends which mate with the head component and the cap components (12, 14, 24), and the wire includes a first interface component, being threads, and the substantially flat cap (12,14,24) have a second interface component, also being threads, the two interfaces

mate such that the cap translates in only one direction because the cap components are lock nuts, which lock onto the wire as they are screwed on and don't allow for removal or reverse translation (claim 6, column 4, lines 47-50), one embodiment of the cap (12) also having external cutting threads. Additionally, the cap in the nut embodiment, is configured to mate with the head of a wrench. The head component includes a tip and threads, which cut into the bone upon insertion. The wire is configured to extend through the surface of bone and the cap (12, 14, 24) is configured to mate with another surface of the bone whereby two pieces of bone are compressed against each other (Figures 2-4, column 3, lines 30-36) via tension on the wire.

Claims 1, 6, 8, 10, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Galline (US Pat# 4889110). Galline discloses a head (22, 23), a wire (21), a substantially flat cap (2, 3) and a plate (11). A tensioner (Figure 4) may be employed to increase tension on the wire and included a tension measurement gauge (42a).

Claims 1, 3, 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (US Pat# 5423820). Miller discloses a head (34) configured to mate with the tool in figure 1, a wire (11), a cap (33). The tool of figure 1 is a tensioner with a gauge (26) to measure tension and includes a cannulated rod (22) and is configured to receive the wire and gears. Please note the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure.

Claims 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by McLaren (US Pat# 5100405). McLaren discloses a substantially flat cap (10) having an outside and inside surface, including an interface component (24) and outside surface cutting threads (16, 18). The cap has a center hole (24) for a wire and an additional hole(opening) (56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 7, 17, 18, 20, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Songer (US Pat# 5611801) in view of McLaren (US Pat# 5100405). Songer discloses a head (12) mated with a wire (24), inserting the head, using a drill, into the first and second surface of two bone fragments, extending the wire through the surface, where excessive wire is removed (column 3, lines 15-17). Songer, however, lacks a threaded cap with additional hole. McLaren teaches a cutting threaded cap with threads (16, 18) and additional hole 56, as described supra. It would have been obvious to one of ordinary skill in the art to use system and method, as taught by Songer with the cap of McLaren such that it provides the ability to secure the cable to the bone and provide adequate tension to secure the bones together.

Claims 17, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Songer (US Pat# 5611801) in view of McLaren (US Pat# 5100405) and in further view of Hardinge (US Pat # 2381050). The teachings of Songer and McLaren are provided supra, however they lack a cut in the planar surface of the cap to facilitate expansion of the cap. Hardinge teaches a planar surface cut to facilitate in expansion of the element within a bony structure. It would have been obvious to one of ordinary skill in the art to use an expandature aiding cut, as taught by Hardinge with the system of Songer and cap of McLaren such that it provides the ability to expand the element within a bony element to aid in fracture reduction and element retention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,8 & 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6736819. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the current application is much broader than that of claim 1 in US Pat#6736819 and anticipates it. See *In re Goodman*.

Claims 17 & 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6736819. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 17 of the current application is much broader than that of claim 2 in US Pat#6736819 and anticipates it. See *In re Goodman*.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Livingston (US Pat# 2490364)- bone pin; Silvestrini (US Pat# 4708132)- fixation device; Hayhurst (US Pat# 4741330)- anchoring apparatus; Martins (US Pat# 5306290)- suture button; Magovern (US Pat# 6033429) – system for closing bone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Amareld, Jr. whose telephone number is 571-272-6170. The examiner can normally be reached on M-F 9am -5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RWA

Robert W Amareld, Jr.
Examiner
Art Unit 3738



BRIAN E. PELLEGRINO
PRIMARY EXAMINER

